



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,780	12/09/2003	Roland Lee Smith	3111	4967

23545 7590 09/23/2004

KATHLEEN M HARLESTON
THE HARLESTON LAW FIRM
909 TALL PINE ROAD
MT PLEASANT, SC 29464

EXAMINER


DEPUMPO, DANIEL G

ART UNIT PAPER NUMBER

3611

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/731,780	Applicant(s) SMITH, ROLAND LEE 	
	Examiner Daniel G. DePumpo	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/9/03</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3611

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 23 recites a “trunk vertical rod assembly”, in addition to the “rear line tab” of claim 22. The specification does not disclose the use of these elements together. At page 14, it is disclosed that trunk rod is an alternative embodiment to be used in place of the rear line tab. It is unclear how these elements can be used together.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, line 2, it appears that “behind” should be – in front of --. This would be consistent with the terminology in claim 6, for example.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3611

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Karr.

Karr teaches a system having the structure as claimed. The device includes a trailer rod 2, a stop (the bumper of the tow vehicle as depicted in fig. 1), a rear mirror tab 3, and a trunk vertical rod 1 which is considered to be "attachable" to a truck lid.

7. Claims 1, 4, 7, 8, 19, 20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Kinnard.

Kinnard teaches a system having the structure as claimed. The device includes a trailer rod 120, a stop (either the truck bumper, or the vertical section of the hitch that is in front of the hitch ball as depicted in fig. 1A), a rear mirror tab (paragraph 43) and a rear line tab (paragraph 43). The tab is considered to be "attachable" to the rear mirror adjuster switch.

Art Unit: 3611

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 18, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnard in view of Anderson.

As set forth above, Kinnard teaches substantially all that is claimed, but does not teach that the trailer rod is telescoping and pivotal, or the use of a trunk rod. Anderson, however teaches a telescoping (para. 35) and pivotal trailer rod 32. It would have been obvious to modify Kinnard by making the trailer rod telescoping and pivotal, as taught by Anderson, to provide for adjustability to accommodate different sized vehicles. Anderson also teaches the use of a trunk rod 29. It would have been obvious to modify Kinnard, by including a trunk rod, as taught by Anderson, to provide an alignment device that is easily visible and is adaptable to various types of vehicles.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnard in view of Bohnet.

As set forth above, Kinnard teaches substantially all that is claimed, but does not teach that the trailer rod is affixed to a center of a top surface of the trailer socket by a magnet. Bohnet, however, teaches a similar device having a trailer rod 27 which is attached to the socket by a magnet. It would have been obvious to modify Kinnard, by using a trailer rod having the structure taught by Bohnet, to provide a less complex device that can be easily installed and removed.

Art Unit: 3611

11. Claims 2, 11, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kinnard and Bohnet as applied to claim 3 above, and further in view of DeShazer.

As set forth above, the combination teaches substantially all that is claimed, but it is unclear how the rod 35 of Bohnet is attached to the sleeve 34. DeShazer, however, teaches a similar device having a common detachable pin 38. It would have been obvious to modify the combination, by mounted the rod to the sleeve using a detachable pin, as taught by DeShazer, since Bohnet is silent regarding the fastening means, and since pin taught by DeShazer would provide a common, inexpensive and secure fastening means.

12. Claims 5, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kinnard, Bohnet and DeShazer as applied to claims 2, 11, 12 and 17 above, and further in view of Ricles.

As set forth above, the combination teaches substantially all that is claimed, but does not teach the details of the stop. Ricles, however, teaches a stop having a triangular brace 32'. Regarding claim 13, element 32 of Ricles is considered comprise the stop. It would have been obvious to modify the combination, by including a stop having the structure taught by Ricles, to provide protection for the tow vehicle.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kinnard, Bohnet and DeShazer as applied to claims 2, 11, 12 and 17 above, and further in view of Tusche.

As set forth above, the combination teaches substantially all that is claimed, including the use of removable stickers (Kinnard) for the line tabs, but does not specifically disclose that they

Art Unit: 3611

are incorporated into a transparent sheet. Tusche, however discloses alignment tabs that are clear or transparent (col. 5, line 67). It would have been obvious to modify the combination by making the tabs transparent, as taught by Tusche, to minimize interference with the driver's vision (col. 6, lines 1 and 2).

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kinnard, Bohnet, DeShazer and Ricles as applied to claims 5, 6 and 13 above, and further in view of Law.

As set forth above, the combination teaches substantially all that is claimed, but does not teach a suction cup on the rear tab. Law, however, teaches a similar device including a suction cup on rear tab 34. It would have been obvious to modify the combination by including a suction cup on the rear tab, as taught by Law, to provide a reusable fastener that is easily installed and removed.

15. Claims 14, 15 and 16 are is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kinnard, Bohnet and DeShazer as applied to claims 2, 11, 12 and 17 above, and further in view of Potts.

As set forth above, the combination teaches substantially all that is claimed, but does not teach the use of an L-shaped, or U-shaped attachment assembly. Potts, however, teaches a similar device including an attachment assembly that is both L-shaped and U-shaped. It would have been obvious to modify the combination by including such a bracket, as taught by Potts, to provide a sturdy attaching means that is easy to install and remove. Regarding claim 16, Official Notice is taken that it is notoriously old and well known to provide a threaded connection as a

Art Unit: 3611

mounting means for a rod. It would have been obvious to provide a threaded arrangement so that no special assembly steps, such as welding or crimping, are required.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leber and Sommerfeld disclose various devices having features in common with the instant invention.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel G. DePumpo whose telephone number is 703 308-1113.

The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703 308 1113. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel G. DePumpo
Primary Examiner
Art Unit 3611

dgd
9/20/04